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| 08/872,097 | 06/10/97 | FEYGIN | I 301.0001 |

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IM22/0811

EXAMINER

SNAY, J

ART UNIT

PAPER NUMBER

1743

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 13

Application Number: 08/872,097
Filing Date: June 10, 1997
Appellant(s): FEYGIN ET AL.

MAILED

AUG 11 2000

GROUP 1700

Peter H. Priest
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed April 27, 2000.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: The following three issues are presented:

Whether claims 1-9, 23-29 and 47 are unpatentable under 35 U.S.C. 103 as obvious over the teaching of Gleave et al (US 5,660,727) in view of Panetz et al (US 5,585,068).

Whether claims 17-22, 29 and 35-40 are unpatentable under 35 U.S.C. 103 as obvious over the teaching of Gleave et al (US 5,660,727) in view of Averette (US 5,147,551).

Whether claims 48-65 are unpatentable under 35 U.S.C. 103 as obvious over the teaching of Gleave et al (US 5,660,727) in view of Panetz et al (US 5,585,068), as applied to claim 47, and further in view of Park et al (US 3,715,190).

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-9, 17-29, 35-40 and 47-65 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

| | | |
|---------|--------------|---------|
| 5660727 | GLEAVE ET AL | 8-1997 |
| 5585068 | PANETZ ET AL | 12-1996 |
| 5147551 | AVERETTE | 9-1992 |
| 3715190 | PARK ET AL | 2-1973 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-9, 23-29 and 47 are rejected under 35 U.S.C. 103, as unpatentable over Gleave et al in view of Panetz et al. This rejection is set forth in prior Office Action, Paper No. 10, paragraph 4.

Claims 17-22, 29 and 35-40 are rejected under 35 U.S.C. 103, as unpatentable over Gleave et al in view of Averette. This rejection is set forth in prior Office Action, Paper No. 10, paragraph 5.

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Claims 48-65 are rejected under 35 U.S.C. 103, as unpatentable over Gleave et al in view of Panetz et al, and further in view of Park et al. This rejection is set forth in prior Office Action, Paper No. 10, paragraph 6.

(11) Response to Argument

Appellant argues that Gleave et al and Panetz et al address a distinctly different context than the present invention, i.e. combinatorial chemical synthesis or universal fluid exchange. The argument is not persuasive because a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Additionally, the recitation of combinatorial chemical synthesis reaction tool has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

Appellant further argues that Gleave et al does not include the capability of injecting and evacuating fluid into and from multiple reaction vessels as taught by the present invention. The argument is not persuasive because the secondary teaching of Panetz et al provides such capability as well as the motivation to so modify the apparatus of Gleave et al, as described in the grounds of rejection.


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Appellant further argues that the columns taught by Panetz et al do not meet the presently claimed reaction vessel, and the overall arrangement of Panetz et al does not meet the presently claimed injection and evacuation ports and their respective fillings.

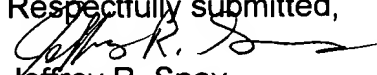
The argument is not persuasive because those elements alleged by Appellant as missing from Panetz et al are in fact provided by Gleave et al. This and the remainder of Appellant's arguments are directed to the references individually, and neither address nor obviate the finding of obviousness based on the disclosure of the combination of the recited references as a whole.

For the above reasons, it is believed that the rejections should be sustained.

Conferee


Paul Thibodeau
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Art Unit 1773

Respectfully submitted,


Jeffrey R. Snay
Primary Examiner
Art Unit 1743

jrs
August 10, 2000

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